

MAR 20 2001

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## THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Himmelspach et al.

Art Unit: 1645

Serial No.: 09/632,722

Examiner: To be assigned

Filed: August 4, 2000

For: FACTOR X ANALOG WITH AN IMPROVED  
ABILITY TO BE ACTIVATED

## PETITION AND FEE FOR EXTENSION OF TIME

Box Missing Parts  
Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. 1.136(a), an extension of time (for Large Entity) of:

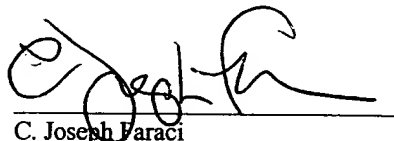
One Month	[ ]	\$110.00
Two Months	[ ]	\$390.00
Three Months	[ ]	\$890.00
Four Months	[X]	\$1,390.00

is hereby requested to

☒ [X] respond to Notice to File Missing Parts of Nonprovisional Application mailed October 2, 2000☐ [ ] file a response to office action mailed on \_\_\_\_\_☐ [ ] file an Appeal Brief now due☐ [ ] other (specify): \_\_\_\_\_

The requisite fee pursuant to 37 C.F.R. 1.17 is to be charged to Deposit Account No. 02-1437 (P-235.00). A duplicate of this sheet is enclosed.

Respectfully submitted,



C. Joseph Paraci

Registration No. 32,350

Telephone: (949) 250-6827

Facsimile: (949) 474-6330

BAXTER HEALTHCARE CORPORATION  
Post Office Box 15210  
Irvine, CA 92623-5210

## CERTIFICATE OF EXPRESS MAILING

I hereby certify that this document (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Label No. EL524824408US in an envelope addressed to: Box Missing Parts, Assistant Commissioner for Patents, Washington, D.C. 20231, on March 19, 2001.

By



Diane Branham

Approved for use the 10/31/2002. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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# **PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)**

Docket Number (Optional)  
20895C-005700US

In re Application of HIMMELSPACH et al.

Application Number 09/632,722

Filed August 4, 2000

For FACTOR X ANALOG WITH AN IMPROVED ABILITY TO BE  
ACTIVATED

Group Art Unit  
1653

Examiner  
Robinson, Hope A.

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

- |   |       |
|---|-------|
| <input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1)) | \$110 |
| <input type="checkbox"/> Two months (37 CFR 1.17(a)(2))           | \$    |
| <input type="checkbox"/> Three months (37 CFR 1.17(a)(3))         | \$    |
| <input type="checkbox"/> Four months (37 CFR 1.17(a)(4))          | \$    |
| <input type="checkbox"/> Five months (37 CFR 1.17(a)(5))          | \$    |

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ .

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 20-1430.

I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71

Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ attorney or agent of record.

☐ attorney or agent under 37 CFR 1.34(a).

Registration number if acting under 37 CFR 1.34(a). \_\_\_\_\_

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

July 7, 2003

Date

*Scott L. Ausenhus*

Signature

Scott L. Ausenhus, Reg. No. 42,271

Typed or printed name

NOTE: Signatures of all the Inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

Burden Hour Statement: This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

07/23/2003 MAIL ROOM 09/04/03 201430 09/03/03  
01 FC:1251 DE 7109542 110.00 DA

# PATENT APPLICATION FEE DETERMINATION RECORD

Effective December 29, 1999

Application or Docket Number

9/632722

## CLAIMS AS FILED - PART I

(Column 1)

(Column 2)

FOR	NUMBER FILED	NUMBER EXTRA
BASIC FEE		
TOTAL CLAIMS	43 minus 20=	* 23
INDEPENDENT CLAIMS	2 minus 3 =	*
MULTIPLE DEPENDENT CLAIM PRESENT		

\* If the difference in column 1 is less than zero, enter "0" in column 2

## CLAIMS AS AMENDED - PART II

(Column 1)

(Column 2)

(Column 3)

AMENDMENT A		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	*		Minus	**	=
Independent	*		Minus	***	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					

(Column 1)

(Column 2)

(Column 3)

AMENDMENT B		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	*		Minus	**	=
Independent	*		Minus	***	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					

(Column 1)

(Column 2)

(Column 3)

AMENDMENT C		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	*		Minus	**	=
Independent	*		Minus	***	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20."

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3."

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

SMALL ENTITY TYPE ☐

OR

OTHER THAN SMALL ENTITY

RATE	FEE
	345.00
X\$ 9=	
X39=	
+130=	
TOTAL	

OR

OR

OR

OR

OR

RATE	FEE
	690.00
X\$18=	414
X78=	
+260=	
TOTAL	1104

SMALL ENTITY

OR

OTHER THAN SMALL ENTITY

RATE	ADDITIONAL FEE
X\$ 9=	
X39=	
+130=	
TOTAL ADDIT. FEE	

OR

OR

OR

OR

OR

RATE	ADDITIONAL FEE
X\$18=	
X78=	
+260=	
TOTAL ADDIT. FEE	

RATE	ADDITIONAL FEE
X\$ 9=	
X39=	
+130=	
TOTAL ADDIT. FEE	

OR

OR

OR

OR

OR

RATE	ADDITIONAL FEE
X\$18=	
X78=	
+260=	
TOTAL ADDIT. FEE	

RATE	ADDITIONAL FEE
X\$ 9=	
X39=	
+130=	
TOTAL ADDIT. FEE	

OR

OR

OR

OR

OR

RATE	ADDITIONAL FEE
X\$18=	
X78=	
+260=	
TOTAL ADDIT. FEE	



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,722	08/04/2000	Michele Himmelspace	235.00	2874

7590 05/06/2003  
Baxter Healthcare Corporation  
P O Box 15210  
Irvine, CA 92614

EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 05/06/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/632,722

Applicant(s):  
Himmelspach et al.

Examiner  
HOPE ROBINSON

Art Unit  
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 24, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-43 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**Restriction/Election**

Restriction to one of the following inventions is required under

5 35 U.S.C. 121:

- I. Claims 1-15 and 17-33 are drawn to a factor X analog of SEQ ID NO:  
and a preparation, classified in class 530, subclass 350.
- 10 II. Claims 16 and 34-43 are drawn to a recombinant DNA, classified in  
classes 435 and 536, subclass 69.1, 7.1 and 23.1.

The inventions are distinct, each from the other because of the  
following reasons:

15 The DNA of Invention II is related to the proteins of Invention I by  
virtue of encoding same. The DNA molecule has utility for the recombinant  
production of the protein in a host cell. Although the DNA molecule and  
protein are related since the DNA encodes the specifically claimed protein,  
they are distinct inventions because the protein product can be made by  
20 another and materially different process, such as by synthetic peptide  
synthesis or purification from the natural source. Further, the DNA may be  
used for processes other than the production of the protein, such as nucleic  
acid hybridization assay.

25 Because these inventions are distinct for the reasons given above and  
have acquired a separate status in the art as shown by their different  
classification, restriction for examination purposes as indicated is proper.

Serial Number 09/632,722  
Art Unit 1653

Furthermore, the inventions have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. A reference which would anticipate the invention of one group would not necessarily anticipate or make obvious the other group. Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, election of a single group for examination purposes as indicated is proper.

A telephone call was made to the applicant's attorney Mr. Scott Ausenhus on April 24, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made. A written restriction is being submitted and applicant is required to make an election to prosecute the claims.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from

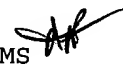
Serial Number 09/632,722  
Art Unit 1653

the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 6:00 P.M. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope A. Robinson, MS   
Patent Examiner

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600



FAX RECEIVED

JUL 08 2003

GROUP 1600

Atty Docket No. 20695C-005700US

PTO FAX NO.: 1.703.308.4242

ATTENTION: Examiner Robinson, Hope A.  
TELEPHONE NO.: 1.703.308.6231

Group Art Unit 1653

**OFFICIAL COMMUNICATION  
FOR THE PERSONAL ATTENTION OF  
EXAMINER Robinson, Hope A.**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

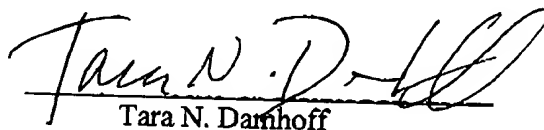
I hereby certify that the following document(s) in re Application of HIMMELSPACH et al., Application No. 09/632,722, filed August 4, 2000 for FACTOR X ANALOG WITH AN IMPROVED ABILITY TO BE ACTIVATED is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal Form
2. Fee Transmittal
3. Petition for One-Month Extension of Time
4. Response To Restriction Requirement (2 pages)

Number of pages being transmitted, including this page: 6

Dated: July 7, 2003

  
Tara N. Danhoff

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY  
RETURN FACSIMILE AT (415) 576-0300**

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, CA 94111-3834  
Telephone: 303-571-4000  
Fax: 303-571-4321